

Nevertheless, Applicants will respond to the Office Action on the merits below. However, it is expected that in view of the below Remarks, the Examiner will now pass the application immediately to issue.

In paragraph 2 at pages 2-5 of the Office Action, the Examiner has rejected claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,660,419 of Nishida et al. Further, in paragraph 4 at pages 5 and 6 of the Office Action, the Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Nishida et al. in view of Japanese Published Patent Application JP 11-126620 (JP '620). The Examiner notes that Nishida et al. has a common inventor/assignee with the present application, but contends that based upon the earlier effective U.S. filing date of Nishida et al., it constitutes prior art under 35 U.S.C. § 102(e). The Examiner then suggests ways in which the rejection under 35 U.S.C. § 102(e) might be overcome. The Examiner goes on to discuss the alleged disclosures of Nishida et al. and JP '620, but these will not be repeated, since they are irrelevant to the present response.

The Examiner's rejections are respectfully but strenuously traversed because, contrary to the Examiner's contention, Nishida et al. is not prior art under 35 U.S.C. § 102(e), for the reasons set forth in detail below.

First, although the Examiner does not state what he believes to be the effective U.S. filing date of Nishida et al., it is assumed that the Examiner is referring to the International filing date of June 28, 1999, when the PCT application of Nishida et al. was filed. However, the PCT application of Nishida et al. was filed and published in the Japanese language. Therefore, the effective filing date of Nishida et al. under 35 U.S.C. § 102(e) is not the International filing date, but the actual date of completion of the requirements of the National Phase application in the United States under 35 U.S.C. § 371, namely December 18, 2000.

Second, the filing date of the present application in the United States is its International filing date, namely August 30, 2000. Since August 30, 2000 is prior to the December 18, 2000 prior art date of Nishida et al. under § 102(e), Nishida et al. cannot be prior art against the present application under 35 U.S.C. § 102(e). Therefore, reconsideration and withdrawal of the rejection of claims 1 and 4 under 35 U.S.C. § 102(e) are respectfully requested.

Third, Nishida et al. is not prior art against the present application under 35 U.S.C. § 102(a) or § 102(b), or any other subsection of 35 U.S.C. § 102. The earliest effective prior art date of Nishida et al. is its PCT publication date of January 6, 2000. This publication date is not more than one year prior to the August 30, 2000 International filing date, and therefore the U.S. filing date of the present application. Therefore, Nishida et al. is not prior art against the present application under 35 U.S.C. § 102(b).

Fourth, although the January 6, 2000 publication date of Nishida et al. is prior to the International and U.S. filing date of August 30, 2000 for the present application, it is not prior to the Japanese priority date of September 2, 1999, to which the present application is entitled. A Verified English Translation of the Japanese priority application Hei 11-248349 was submitted with the Amendment filed October 2, 2003 in the present application. A cursory review of this Verified Translation reveals that it fully supports the present claims. Therefore, the effective filing date of the present application (August 30, 1999) is prior to the § 102(a) publication date of Nishida et al. A rejection under 35 U.S.C. § 102(a) based upon Nishida et al. would therefore also not be proper.

Fifth, the rejection under 35 U.S.C. § 103(a) is not proper for the same reasons as discussed above, because Nishida et al. is not prior art to the present application under any of the subsections of 35 U.S.C. § 102. In any event, even if Nishida et al. were effective prior art under 35 U.S.C. § 102(e), the rejection under 35 U.S.C. § 103(a) is improper, because Nishida et al. and the present invention are commonly owned, and all of the claims of the presently pending application were commonly owned at the time of the present invention. Therefore, a rejection of the present claims under 35 U.S.C. § 103(a) would also be precluded under the provisions of 35 U.S.C. § 103(c). Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested for both of the above reasons.

In sum, Nishida et al. is not prior art against the present application under any basis of which Applicants is aware. Therefore, all of the rejections based upon Nishida et al. are improper. Reconsideration and an early Notice of Allowance are therefore respectfully solicited.

Respectfully submitted,

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September 21, 2005 By: William W. Schwarze
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